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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
09/488,037	01/19/00	WINTER	A	HOE-92/F-253

HM12/0205

CONNOLLY BOVE LODGE & HUTZ LLP
1220 MARKET STREET
PO BOX 2207
WILMINGTON DE 19899

EXAMINER	
NAZARIO GONZALEZ,P	
ART UNIT	**PAPER NUMBER**
1621	8

DATE MAILED: 02/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.	Applicant(s)
09/488,037	Winter et al.
Examiner	**Group Art Unit**
Porfirio Nazario-Gonzalez	1621

THE PERIOD FOR RESPONSE: [check only a) or b)]

a) ☐ expires _____ months from the mailing date of the final rejection.

b) ☒ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on *Jan 18, 2001* **has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:**

☐ The proposed amendment(s):

☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☐ will not be entered because:

☐ they raise new issues that would require further consideration and/or search. (See note below).

☐ they raise the issue of new matter. (See note below).

☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

☐ Applicant's response has overcome the following rejection(s):

_____

☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attachment

☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: _____

Claims objected to: _____

Claims rejected: *1-3*

☐ The proposed drawing correction filed on _____ ☐has ☐has not been approved by the Examiner.

☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ .

☐ Other

Response to Arguments

1. Applicant's arguments filed on January 18, 2001 have been fully considered but they are not persuasive. Applicants arguments are two fold; (I) that the amended claims are patentably distinct from the of Interference No. 104,447 and (ii) that *In re Kroekel et al.*, 231 U.S.P.Q. 640 (CAFC 1986) is not applicable to the facts in the instant case. The Examiner respectfully disagrees. In the first instant, Count 1 of Interference No. 104,447 as stated on Page 46 of Paper No. 1 (NOTICE DECLARING INTERFERENCE) is as follows:

A composition of matter according to claim 1 of Winter,
or
a composition of matter according to claim 11 of Karl.

2. The instant amended claim 1 is narrower in scope than Claim 1 of Winter, which corresponds to the Count. In the Count (Claim 1 of Winter) the variables R^{11}, R^{12} and R^{13} can be the same or different whereas in the amended instant claim 1 only R^{11} and R^{12} are different from each other. Furthermore, the scope of the variable R^7 in the instant amended claim 1 is narrower than the variable R^7 in the Count. It is clear that the subject matter in amended claim 1 overlap with the subject matter on Count 1 of the interference and thus is not patentably distinct from the Count. As for Applicants arguments concerning *In re Kroekel et al.*, on page 643 the Court states:

> The issue presented is whether Kroekel, having never attempted to include in the interference subject matter which dominates the lost count, may now successfully claim that subject matter.

The Court said no. Further, the Court states that the "doctrine of interference estoppel is directed to finality of an interference, at least with respect to all issues which *might have been* presented in the interference." The Interference record shows that Applicants failed to move by filing a motion under 37 CFR § 1.633(c)(1) to limit the scope of the Interference Count to only include compounds where the variables R^{11}, R^{12} and R^{13} are the same rather than the variables R^{11}, R^{12} and R^{13} been the same or different as in the Interference Count. Thus, the Court reaffirmed the principle that the losing party is prevented from claiming subject matter that does not exclude the precise subject matter in the Count (which the losing party alleges to be patentably distinct from the Count) when said argument have not been raised or presented in a motion during the interference proceedings. Thus, claims 1-3 stand rejected on the basis of interference estoppel under 37 CFR § 1.658(c).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Nazario-Gonzalez whose telephone number is (703) 308-4632. The Examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Johann Richter, can be reached on (703) 308-4532. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

PNG
February 2, 2001

Porfirio Nazario-González
PORFIRIO NAZARIO-GONZALEZ
PRIMARY EXAMINER
TC GROUP ~~1200~~ 1600